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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,794	09/22/2003	Keiko Shiraishi	115031	7273
25944	7590	12/12/2007		
OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850			EXAMINER BLACKWELL, JAMES H	
			ART UNIT 2176	PAPER NUMBER
			MAIL DATE 12/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/665,794

Applicant(s)

SHIRAISHI ET AL.

Examiner

James H. Blackwell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to an amendment filed 08/30/2007 and a supplemental amendment filed 09/21/2007.
2. The priority date is **09/20/2002**.
3. Claims 8-9, and 11-13 were cancelled, and claims 14-16 were added with the amendment filed 08/30/2007;
4. Claims 1-7, and 14-16 are pending.
5. Claims 1-3 are independent claims.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. The claimed invention is directed to non-statutory subject matter. Claims 1, 4-7, and 14. Claim 1 recites a linking information making device containing various units. However, no mention is made of a computer-readable, tangible media embodying the device, nor is any hardware suggested. Thus, Claims 1, and 14 are at best software per se. Software per se is not statutory. Claims 4-7 recite a system with a series of devices. Again, no hardware is recited in the system, nor any computer-readable, tangible media to embody the "device." Thus, the claims describe no more than software per se. Software per se is not tangible.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Robles et al. (hereinafter Robles, U.S. Patent Application Publication No. 2002/0198904 filed 06/22/2001, published 12/26/2002).

In regard to independent Claim 1, Robles discloses:

- *A linking information making device (Abstract → describes a distributed document production system that provides a means to obtain information directly from available devices as well as to store such information in a database, and to allow for the creation and execution of workflows based on the device information obtained), comprising:*
 - *a service list acquisition unit which acquires a service list expressing respective services which execute predetermined processings of document data, the respective services being provided by service processing devices (Pg. 3, Paragraphs [0028], [0031-0035] → a services engine can retrieve information on available services directly from production devices using SNMP (Simple Network Management Protocol).*

The information includes the particular services and options for those services. Robles also implies that instructions for generating user accessible controls pertaining to each device as well as the name or other location identifier of each device capable of providing the services may be included in this information obtained directly from the device(s). This interpretation is based on what is optionally contained in a services database and the notion that the services engine can either obtain this information from the database or directly from the device(s)).

- *an interface information acquisition unit which acquires from the respective service processing devices pieces of interface information corresponding to the respective service processing devices* (Pg. 3, Paragraph [0028] → as noted above, Robles implies that instructions for generating user accessible controls (e.g., a GUI, which would presumably contain interface information since the GUI is controlling the device) pertaining to each device as well as the name or other location identifier of each device capable of providing the services may be included in this information obtained directly from the device(s))
- *the interface information including a method by which the predetermined processing is started* (Pg. 4, Paragraph [0039]; Figs. 10-13 → a print command is issued, and available devices are provided for selection. Once a given device(s) is/are selected, the services engine generates a user interface with user accessible controls for selecting services options,

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etc. A production plan (i.e., workflow) is then generated. That a production plan is generated by the combination of services and their options, Robles implies that the interface information would have to have included information on how to execute each of the services since the production plan would not execute without such information).

- *a linking information making unit which makes linking information to be used for linking the predetermined processings based on the interface information which has been acquired by the interface information acquisition unit, and transmits the linking information, the linking information including information to be displayed on a screen of a one or more service processing devices and to be selected by a user operating the screen when the user instructs to start linking the predetermined processings* (Pg. 3, Paragraph [0032] → Plan generator 68 is responsible for merging formatted production request 44 with selected services 46, as illustrated in Fig. 3. Device drivers 70 translate the production plan 44 into a specialized set of commands for each selected production device 16 handling production plan 44. Beneficially, when a new production device is added to network 10, the drivers for that device need only be installed on server 14 updating production engine 42. It is envisioned that update service 64 will also identify new devices connected to network 10 and update device drivers 70 with drivers for the newly identified services). The Plan Generator described in Robles is interpreted to perform the

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"linking" function as it merges the services/options and specific device interface information into a plan (workflow)).

- *a management unit which stores the transmitted linking information and further transmits the stored linking information to the one or more service processing devices for displaying on the screen based on a request from the service processing devices* (Pg. 5, Paragraph [0047]; Fig. 14 → describes a production management interface generated by production engine 42 and used for monitoring and managing document production plans. Interface 158 displays the status of each production plan generated by production engine 42 as well as user accessible controls for directing how production engine 42 manipulates those plans. In the example of FIG. 14, production management interface 158 displays the status of three plans--Story, Brochure, and Catalog. Story is to be produced on Printer A and then bound. Brochure is to be delivered via fax and electronic mail. Catalog is to be produced on Printer B. Interface 158 includes manipulation controls 160, 162, and 164 for controlling each plan. For example, interface 158 shows that Printer B is malfunctioning. Highlighting catalog and then selecting redirect control 164 allows the plan to be delivered to a functioning printer).

Regarding independent Claims 2 and 3, Claims 2 and 3 merely recite a method, and program on a recording medium operable (executable) on the device of

Claim 1. Thus, Robles discloses every limitation of Claims 2 and 3, as indicated in the above rejection of Claim 1.

In regard to dependent Claim 4, Robles discloses:

- *A document processing system, comprising:*
 - *the linking information making device according to claim 1 which acquires the service list transmitted from a search device and the pieces of the interface information from the service processing devices via the search device (Pg. 3, Paragraph [0028] → describes a services engine (a search device) that obtains information from service devices directly, and is further capable of periodically updating that information), further comprising:*
 - *a plurality of service processing devices which provide services for executing predetermined processings of document data and transmit the pieces of the interface information to the search device (Pg. 3, Paragraph [0028]; Fig. 8 → Fig. 8 depicts a plurality of production devices capable of providing services and transmitting services/capabilities to the services engine upon request).*
 - *the search device provided with:*
 - *a service information storage unit for storing the pieces of the interface information which have been transmitted from currently-available service processing devices (Pg. 3, Paragraph [0028] → a*

services database is available to provide electronic storage to device services/options available on a network or elsewhere).

- *a search unit for searching services corresponding to services, for which search has been requested, using the pieces of the interface information which have been stored in the service information storage unit* (Pg. 3, Paragraph [0028] → describes a services engine that retrieves (after locating) information on services directly, or alternatively obtains the information from the services database), and
- *a transmission unit which transmits the service list based on the search results of the search unit* (Pg. 3, Paragraph [0031] → a device selector 60 queries services database 38 or devices 16 directly and identifies a device or devices 16 capable of providing the selected services. In other words, the devices are “searched” for, identified, and their available services, options, interface information is transmitted back to the system such that the interface generator 43, can generate a user interface with user accessible controls for selecting between the identified device or devices).

In regard to dependent Claim 5, Robles discloses:

- *the transmission unit of the search device transmit the service list ..., to the linking information making device* (Pg. 3, Paragraph [0032] → Plan generator 68

is responsible for merging formatted production request 44 with selected services 46, as illustrated in Fig. 3. Device drivers 70 translate the production plan 44 into a specialized set of commands for each selected production device 16 handling production plan 44. The Plan Generator described in Robles is interpreted to perform the "linking" function as it merges the services/options and specific device interface information obtained by the services engine into a plan (workflow)).

In regard to dependent Claim 6, Robles discloses:

- *the service processing devices transmit pieces of input information and pieces of output information on services, service names, and service information location as the interface information (at least Pgs. 2-3, Paragraphs [0027-0028], [0031] → service devices via SNMP transmit, at least upon request, information on their services as well as interface information, their location, and identification).*

In regard to dependent Claim 7, Robles discloses:

- *interface information acquisition unit of the linking information making device acquires pieces of service information location for accessing the respective service processing devices, from the search device, and acquires pieces of interface information from the service processing devices based on pieces of the acquired service information location (Pg. 3, Paragraphs [0028], [0031] → the services engine includes a services locator 58, device selector 60. The services*

locator obtains services and interface information from each of the devices either via database or directly).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robles in view of Roche (U.S. Patent Application Publication No. 2004/0039647 filed 07/18/2001, Published 02/26/2004).

In regard to dependent Claim 14, Robles fails to disclose:

- *the linking information is a file in an XML format.*

However, Roche discloses *the linking information is a file in an XML format* (Figs. 14-18 → Fig. 14 depicts an XML-based Work Order containing, in addition to other information such as what to print and where, how to print (1402). This is further described in Fig. 17 and represents the parameters needed by a device (and presumably obtained by the system from the device) embodied in an XML format).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the disclosures of Robles and Roche since both are related to facilitating the printing of content to devices. Adding the disclosure of Roche

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provides the benefit of using the implicit structure of XML to describe aspects of the overall print job).

Regarding dependent Claims 15 and 16, Claims 15 and 16 merely recite a method, and program on a recording medium operable (executable) on the device of Claim 14. Thus, Robles in view of Roche discloses every limitation of Claims 15 and 16, as indicated in the above rejection of Claim 14.

Response to Arguments

11. An interview was conducted on September 18, 2007. During that interview, Applicants' representative explained the distinctions of the present claims over U.S. Patent No. 5,872,569 ("Salgado"). The Examiner generally agrees that Salgado, based on the arguments provided by the Applicant and from a more thorough review of comments accompanying the amendment filed 08/30/2007, fails to disclose the limitations and withdraws the rejection. A new rejection is therefore provided based on the prior art of Robles et al. and the combination of Robles with Roche.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on 8-4:30 M-F.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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12/07/2007

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